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Filed : January 22, 2007

### REMARKS

Claims 1 and 3 have been amended. The amendments add no new matter and are fully supported by the specification, claims, and drawings as originally filed. In particular, support for the amendments can be found, for example, at page 8, first full paragraph and at page 8, third full paragraph. Accordingly, no new matter has been introduced. Entry of the amendments and reconsideration is respectfully requested.

Claims 33-34 have been canceled herein without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the canceled claim in this or any other patent application.

Upon entry of the foregoing amendments, Claims 1-18 and 21-32 are presented for examination.

#### **Discussion of Rejection Under 35 U.S.C. § 112, first paragraph - Enablement**

Claims 1, 3-18, and 21-34 are rejected as allegedly not being described in the specification in such a way as to enable the skilled artisan to make and use the invention commensurate in scope with the claims. The Office Action states that the specification is enabling for a recombinant promoter comprising the promoter sequence of SEQ ID No. 1 and the intron sequence of SEQ ID No. 2, a chimeric gene comprising said recombinant promoter operably linked to a coding sequence of interest, a method of transforming a plant with said chimeric gene, and a transgenic plant and progeny thereof comprising said recombinant promoter or chimeric gene. However, the Office Action states that the Applicants have not provided guidance for teaching promoter regions having at least 90% sequence identity to SEQ ID NO: 1 or 2.

Applicants respectfully submit that the full scope of the claims is enabled in light of the teachings of the specification and the knowledge in the art at the time of filing of the instant application. Nevertheless, for the purpose of expediting prosecution, Applicants have canceled Claims 33-34, have amended Claim 1 to recite "wherein the first and/or second sequence of the promoter region have a *sequence identity of at least 98%* to the sequences of SEQ ID No. 1 and/or SEQ ID No. 2" [emphasis added], and have amended Claim 3 to recite promoter regions

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*“having at least 98% sequence identity* to the nucleic acid sequence of SEQ ID NO. 3” [emphasis added]. In view of the claim amendments, Applicants respectfully request withdrawal of this rejection.

**Discussion of Rejection Under 35 U.S.C. § 112, First Paragraph – Written Description**

Claims 1, 3-18, and 21-34 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action states that the specification fails to sufficiently describe the claimed invention that one skilled in the art would recognize that Applicants are in possession of the invention as broadly claimed.

Applicants respectfully submit that the full scope of the claims is adequately described. Nevertheless, for the purpose of expediting prosecution, Applicants have canceled Claims 33-34, have amended Claim 1 to recite “wherein the first and/or second sequence of the promoter region have a *sequence identity of at least 98%* to the sequences of SEQ ID No. 1 and/or SEQ ID No. 2” [emphasis added], and have amended Claim 3 to recite promoter regions *“having at least 98% sequence identity* to the nucleic acid sequence of SEQ ID NO. 3” [emphasis added].

Support for the claims as amended can be found, for example, at page 8, first full paragraph and at page 8, third full paragraph of the specification, which respectively state:

Preferably, such promoter variants have a sequence identity of at least 50%, preferably at least 70%, particularly preferably at least 90%, and ***most preferably at least 95% to the promoter sequence given in SEQ ID No. 3*** or parts thereof, in relation to the total DNA sequence shown in SEQ ID No. 3. Preferably, the sequence identity of such promoter sequences is determined by means of comparison with the nucleic acid sequence given under SEQ ID No. 3. In case two nucleic acid sequences of different length are compared to each other, the sequence identity preferably relates to the percentage of the nucleotide residues of the shorter sequence, which are identical to the corresponding nucleotide residues of the longer sequence. [emphasis added].

The percentage degrees of identity given above for SEQ ID No. 3 also apply to the first and second sequences of the promoter region according to the present invention, which are shown in SEQ ID Nos. 1 and 2.

Applicants respectfully submit that the present facts are analogous to those in *In re Wertheim*, 541 F.2d 257 (C.C.P.A. 1976), in which the U.S. Court of Customs and Patent Appeals held that claims reciting a particular range that was not disclosed in *ipsis verbis* in the

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parent application were nevertheless entitled to the benefit of the filing date of the parent application. The claims at issue in the appeal were drawn to a process for preparing a powdered coffee extract. The earlier filed application included a claim reciting "a concentrated aqueous extract of roast coffee containing about 25% to 60% by weight of soluble coffee solids." In holding that the parent application adequately described a claim reciting "between 35% and 60%," the court held that "the PTO has done nothing more than to argue lack of literal support, which is not enough. If lack of literal support alone were enough to support a rejection under §112, then the statement of *in re Lukach*. . .that the 'invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of §112,' is empty verbiage." *In re Wertheim*, 541 F.2d 257, 265.

In other words, even though the application in *In re Wertheim* specifically recited a range of "25% to 60%," the court held that intermediate range values, *i.e.*, 35% to 60%, can be explicitly claimed without violation of the written description requirement, so long as no criticality is ascribed to those values. In the instant specification, Applicants specifically recite a range of 95% to 100%, *i.e.*, "at least 95%." Thus, in accordance with *In re Wertheim*, Applicants can explicitly claim intermediate range values of 98% to 100%, *i.e.*, "at least 98%," without violating the written description requirement. Accordingly, Applicants respectfully submit that the claims as amended are fully supported by the specification and do not add new matter. Thus, the claims satisfy the written description requirement, and Applicants respectfully request removal of this rejection.

#### No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope, the Applicants are not conceding in this application that previously pending claims are not patentable. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or

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any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

### **CONCLUSION**

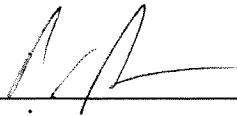
In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues might be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

**KNOBBE, MARTENS, OLSON & BEAR, LLP**

Dated: 2009-03-02

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